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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/049,696	03/27/1998	PATRICIA A. BILLING-MEDEL	6067.US.O1	5914
23492	7590	05/06/2004	EXAMINER	
STEVEN F. WEINSTOCK ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK, IL 60064-6008			MARTINELL, JAMES	
			ART UNIT	PAPER NUMBER
			1631	37
DATE MAILED: 05/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/049,696

Applicant(s)

BILLING-MEDEL ET AL.

Examiner

James Martinell

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40 is/are allowed.
- 6) ☒ Claim(s) 33-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4 & 33</u> . | 6) <input type="checkbox"/> Other: _____ |

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The request to correct the inventorship (filed February 21, 2003) of this nonprovisional application under 37 CFR 1.48(a) is deficient. The request is unnecessary because the "Corrected Declaration and Power of Attorney for United States Patent Application" filed May 15, 2000 did not result in the addition of Mark Hayden as and inventor. The declaration filed May 15, 2000 was not accompanied by a petition under 37 CFR § 1.48. Thus, the inventive entity never included mark Hayden.

The indicated allowability of claim 33-38 is withdrawn in view of the newly discovered reference(s) to Au-Young et al (U.S. Patent No. 6,500,938) and Yu et al (U.S. Patent No. 5,733,748). Rejections based on the newly cited reference(s) follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

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examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 33, 34, 37, and 38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by either one of Au-Young et al (U.S. Patent No. 6,500,938) or Yu et al (U.S. Patent No. 5,733,748). The references disclose nucleic acids that contain 100% of the following SEQ ID NOs of the instant application:

- (a) SEQ ID NO: 1 (compare to Au-Young et al SEQ ID NO: 290, nucleotides 10-232),
- (b) SEQ ID NO: 8 (compare to Au-Young et al SEQ ID NO: 850, nucleotides 1-253),
- (c) SEQ ID NO: 9 (compare to Au-Young et al SEQ ID NO: 850, nucleotides 116-333),
- (d) SEQ ID NO: 10 (compare to Au-Young et al SEQ ID NO: 850, nucleotides 234-462),
- (e) SEQ ID NO: 11 (compare to Au-Young et al SEQ ID NO: 850, nucleotides 345-535),
- (f) SEQ ID NO: 12 (compare to Au-Young et al SEQ ID NO: 850, nucleotides 522-756),
- (g) SEQ ID NO: 17 (compare to Au-Young et al SEQ ID NO: 850, nucleotides 1407-1512), and
- (h) SEQ ID NO: 14 (compare to Yu et al SEQ ID NO: 8, nucleotides 306-553).

The instant claims are not entitled to the effective filing date of parent application Serial No. 08/829,754 because not all of the SEQ ID NOs in the claims has basis in Serial No. 08/829,754.

Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Au-Young et al (U.S. Patent No. 6,500,938) or Yu et al (U.S. Patent No. 5,733,748) in view of applicants' admitted state of the prior art (instant application, pages 35-40). The discussion of each of the prior art references in the previous rejection is incorporated here. Applicants acknowledge the expression of DNAs in host cells via the use of expression vectors and recombinant host cells (instant application at pages 35-

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40) to be old. It would have been obvious for one of ordinary skill in the art at the time the invention was made to express any one of the DNAs disclosed in either one of the primary references by the admittedly old methods in order to produce large amounts of polypeptides.

Claim 40 is allowable over the prior art of record.

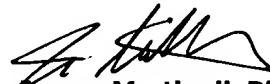
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.

PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.


James Martinell, Ph.D.
Primary Examiner
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5/3/04